

REMARKS

No claims are amended, no claims are canceled, and no claims are added; as a result, claims 1-31 are now pending in this application.

§102 Rejection of the Claims

Claims 1-10 and 13-31 were rejected under 35 U.S.C. § 102(a) as being anticipated by Mueller *et al.* (U.S. 6,185,413). Applicant does not admit that the Mueller *et al.* patent is prior art to the present invention. Applicant respectfully reserves the right to swear behind the Mueller *et al.* patent at a later date. At this time, Applicant chooses to distinguish the Mueller *et al.* patent from the present invention. Applicant respectfully traverses these grounds for rejection of claims 1-10 and 13-31.

Claims 1-10

Claims 1-10 are means-plus-function claims under 35 U.S.C. § 112, paragraph 6. MPEP § 2183 (Manual of Patent Examining Procedure, 8th Ed., Rev. 2, May, 2004) requires the Examiner to make a *prima facie* case of equivalence under 35 U.S.C. § 112, paragraph 6. However, Applicant respectfully submits that the Examiner has not analyzed claims 1-10 in accordance with how the functions of these claims are equivalent to the corresponding elements disclosed in the specification as is required by the MPEP § 2183. Applicant respectfully submits that the Mueller *et al.* patent does not disclose equivalent elements to the corresponding elements disclosed in the specification under 35 U.S.C. § 112, paragraph 6.

It is axiomatic that each word in a claims must be given weight when analyzing claim language. Applicant believes that many of the functions of claims 1-10 have not been viewed properly in light of the equivalent elements in the specification. For example, claim 1 recites a communication device first having "means for interrogating a plurality of wireless network access service providers . . ." wherein the plurality of service providers are queried "to gather information related to service offerings thereof..." [Emphasis Added]

The Mueller *et al.* patent at column 10, lines 43-47 discloses that the location of the mobile station is monitored via an interrogation signal, but fails to teach interrogating the service

providers to gather information related to service offerings. Mueller *et al.* at column 10, lines 49-53 discloses, "In each case, the selection device calculates the current charges for the instantaneous transmission connection and instantaneous call duration for the individual applications stored in the memory 8." [Emphasis Added] Rather than interrogating the service providers for the current charges, Mueller *et al.* at column 8, lines 11-15 discloses,

The corresponding charge information is advantageously stored together with the application data for each application in the memory 8. However, it is also conceivable that the selection device 4 is informed about the charge information via keyboard 3 (which, however, is relatively complex) or via an exchangeable chipcard which contains the charge rates applicable in each case for all mobile radio networks or service providers within the mobile radio networks, before the mobile station is taken into use. [Emphasis Added]

Thus, Mueller *et al.* fails to teach a communication device that interrogates a plurality of wireless network access service providers to gather information related to service offerings thereof, as recited in claim 1.

Another means plus function clause which has not been given its proper weight describes a "means for obtaining a provider selection criterion associated with a user of said communication device..." [Emphasis Added] The Mueller *et al.* patent does not teach obtaining a provider selection criterion associated with a user. Instead, Mueller *et al.* at column 6, lines 12-14 states, "From the applications concerned, the selection device selects the application (i.e., carrier) which is most cost-efficient for the desired connection." Thus, Mueller *et al.* chooses between different carriers based on a single fixed criterion, namely cost, which is not associated with the user of the communication device. Therefore, Mueller *et al.* fails to teach obtaining a provider selection criteria associated with a user, as recited in claim 1.

Another means plus function clause which has not been given its proper weight describes a "means for selecting a service provider from said plurality of wireless network access service providers to provide wireless access to a network for said communication device based on said provider selection criterion and said information." As noted above, the Mueller *et al.* patent does not describe selecting between service providers based upon a provider selection criterion associated with the user. The selection criteria of the Mueller *et al.* patent is simply based on the

most cost-efficient carrier, and therefore fails to teach a provider selection criterion associated with the *user*.

For at least the reasons stated above, Mueller *et al.* fails to teach each of the elements recited in claims 1-10, and thus the Office Action fails to state a *prima facie* case of anticipation with respect to claims 1-10. Therefore, Applicant respectfully requests reconsideration of claims 1-10 and an indication of allowance of these claims.

Claims 13-31

Claim 13 of the present application recites,

interrogating said plurality of network access service providers for information using a wireless interrogation signal; and selecting a service provider from said plurality of network access service providers based on said information and a selection criterion.

Claim 22 of the present application recites,

interrogating a plurality of network access service providers for information relating to service offerings; and selecting a service provider from said plurality of network access service providers based on said information and a selection criterion.

Claim 26 of the present application recites,

an interrogation function to interrogate a plurality of network access service providers that are active in a vicinity of said communication device using interrogation signals transmitted by said wireless transceiver, said interrogation function receiving information from said plurality of network access service providers in response to said interrogation signals; and a selection function to select a service provider from said plurality of network access service providers based on said information received by said interrogation function and a provider selection criterion.

For reasons analogous to those stated above in regards to claims 1-10, Mueller *et al.* fails to teach each of the elements as recited in claims 13, 22, and 26, as quoted above. Hence, the Office Action fails to state a *prima facie* case of anticipation with respect to claims 13, 22, and 26.

Further, claims 14-21 depend from claim 13, claims 23-25 depend from claim 22, and claims 27-31 depend from claim 26. Therefore, these dependent claims include all of the elements of the claim from which they depend. For reasons analogous to those stated above

and the elements in the claims, the Office Action fails to state a *prima facie* case of anticipation with respect to claims 14-21, 23-25, and 27-31.

For at least the reasons stated above, Applicant respectfully requests reconsideration of claims 13-31, and an indication of allowance of these claims.

§103 Rejection of the Claims

Claims 11-12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mueller *et al.* in view of Pecen *et al.* (U.S. 6,466,804). Applicant does not admit that the Pecen *et al.* patent is prior art to the present invention. Applicant respectfully reserves the right to swear behind the Pecen *et al.* patent at a later date. Applicant respectfully traverses these grounds for rejection of claims 11-12.

Applicable Law

The Office Action must provide specific, objective evidence of record for a finding of a teaching, suggestion, or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338 (Fed. Cir. 2002). Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990).

The Present Office Action

The Office Action, in an attempt to meet this requirement, on page 5-6, states, "Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was to utilize a removable memory card, for accessing a communication using SIM card, as taught by Pecen, in order to identify the service provider using information stored in the smart card." Applicant disagrees. The statement, "to identify the service provider using information stored in the smart card" is a merely statement of an alleged result which attempts to reconstruct the claims of the present application using impermissible hindsight. Further, the Office Action

fails to point to any finding of a teaching, suggestion or motivation that is found in the *prior art* that would lead one of ordinary skill in the art to combine Mueller *et al.* with Pecen *et al.* By failing to meet these requirements, the Office Action fails to state a *prima facie* case of obviousness with respect to claims 11-12.

In addition, the Examiner' proposed combination of Mueller *et al.* and Pecen *et al.* also fails to state a *prima facie* case of obviousness with respect to claims 11-12 because the suggested combination fails to teach or suggest each of the elements of claims 11-12.

Claims 11 and 12 are dependent upon the independent claim 1 discussed above. Applicant believes they have established that the Mueller *et al.* patent does not anticipate independent claim 1. Further, Applicant fails to find in Pecen *et al.* the elements in claim 1 that are missing in Mueller *et al.* Therefore, neither Mueller *et al.* nor Pecen *et al.*, either alone or in combination, teach or suggest all of the elements recited in claims 11-12, and so the Office Action fails to state a *prima facie* case of obviousness with respect to claims 11-12.

For at least the reasons stated above, Applicant respectfully requests reconsideration of claims 11-12, and an indication of allowance of these claims.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 373-6904) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date June 20, 2005

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20th day of June, 2005.

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